

February 28, 2006
Case No. GP-301724 (2760/29)
Serial No.: 09/992,855
Filed: November 5, 2001
Page 6 of 10

– REMARKS –

The rejections to claims 22-39 as unpatentable over Parsa in view of Strawczynski is traversed.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP §2143. The cited references fail to establish a *prima facie* case of obviousness.

The rationale to modify or combine the prior art may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. MPEP §2144, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

In this case, the Examiner correctly does not cite to any teachings within any of the references to combine, and merely alleges that "it would have been obvious" to incorporate the teaching of Strawczynski into view of Parsa [sic] in order to reduce the cost of base station and make the base station handle less work. See, page 3 of the December 13, 2005 office action. However, the Examiner cannot conclusively assert that in light of the teachings of either reference any such modification would indeed "reduce the cost of base station" or "make the base station handle less work."

February 28, 2006
Case No. GP-301724 (2760/29)
Serial No.: 09/992,855
Filed: November 5, 2001
Page 7 of 10

Parsa teaches a closed loop power control for common downlink transport channels wherein a base station (i.e. BS 13 in FIG. 1) receives wireless communications from a mobile station (i.e. MS 15 in FIG. 1). Using the loop established between the MS 15 and BS 13, the power level of the MS is adjusted based on the received signal UL. See, e.g. column 9, line 58 – column 10, line 8. In contrast, Strawczynski teaches that a wireless call can be routed through a wireless network and also through a land-based network.

However, as noted by the specification, at page 1, lines 21-29, analog standards may not adequately govern transmission levels across landline networks, making it difficult to set carrier levels in order to maintain proper data transmission. Furthermore, because wireless services focus on voice communications, significant digital signal processing is performed on transmissions through wireless and land-based systems to minimize cross talk, noise, crackling, fading, and dropouts, compromising data transmissions in those systems. See, page 2, line 25 to page 3, line 9.

Those of ordinary skill in the art are aware of such difficulties, and would not be motivated to simply combine the teachings of Parsa with the teachings of Strawczynski – such people would be well aware of the difficulty in maintaining data transmissions over both a wireless and wired network. The mere fact that Parsa can be modified in view of Strawczynski to obtain the claimed invention does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In fact, Parsa unequivocally teaches away from determining signal strength at the *land-based* station (as claimed) by teaching a determination of signal strength at the *base* station. The base station of Parsa is part of the mobile network – under the teachings of Parsa, the signal strength is under exclusive control of the mobile network, rather than outside of the mobile network, as claimed.

February 28, 2006
Case No. GP-301724 (2760/29)
Serial No.: 09/992,855
Filed: November 5, 2001
Page 8 of 10

Furthermore, there must be some reasonable expectation of success, and the Examiner provides no evidence that making the suggested modifications would either "reduce the cost of base station" or "make the base station handle less work." The prior art can only be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. MPEP §2143.02. Here, the Examiner claims that the modification/combination would result in reductions of cost or reductions in workload. However, neither Applicant, nor the references teach relating to the costs of their systems. In light of the absence of cost discussions from the references, the Examiner cannot conclusively assert that such a combination would result in lower cost or workload, since the references do not denounce the costs of the reference systems.

Additionally, Parsa teaches a closed loop power control for common downlink transport channels. Those of ordinary skill in the art are acquainted with closed loop power control techniques in CDMA systems, and know that closed loop power control algorithms use estimates of the received power, as measured at the base station, to instruct mobile units to change transmit power. Such techniques can be effective to compensate for rapid channel variations due to multipath fading when the propagation and processing delays are small as compared to correlation time of the channel. Therefore, one of ordinary skill in the art would not introduce a third location (i.e. mobile unit, base station, and land-based station) into the closed loop power control system due to the necessarily increased propagation and processing delay as compared to the correlation time of the channel. The additional processing and propagation required to transmit the signal would disrupt the correlation with the channel – destroying any possible reasonable expectation of success.

February 28, 2006
Case No. GP-301724 (2760/29)
Serial No.: 09/992,855
Filed: November 5, 2001
Page 9 of 10

Indeed, adding a land-based station would effectively render Parsa unsatisfactory for its intended purpose, in contravention of the strictures of §103(a). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01. Parsa teaches the desirability of a closed loop power control. Adding the land-based station necessarily alters the ratio between propagation and processing delays with correlation time of the channel, since any additional transmissions will increase propagation delays and processing delays. Such an addition would destroy the ability of Parsa to accurately and timely control the power of the mobile station in the Parsa closed loop power control for common downlink transport channels.

Therefore, there can be no proper combination of Parsa with Strawczynski. Withdrawal of the rejections of independent claims 22 and 31, as well as claims 23-30 depending from claim 22 and claims 32-39 depending from claim 31 is requested.

However, in addition, claims 23 and 32 require the signal level of the mobile transceiver represents the second *modem carrier signal* received at the land-based station. Contrary to the Examiner's assertions, Parsa makes no teachings relating to the *modem carrier signal*, much less that the signal level of the mobile transceiver represents the second modem carrier signal received at the land-based station. See, Parsa, column 9 line 58 to column 10, line 9.

Withdrawal of the rejections to claims 22-39 is requested.

February 28, 2006
Case No. GP-301724 (2760/29)
Serial No.: 09/992,855
Filed: November 5, 2001
Page 10 of 10

SUMMARY

The Applicants respectfully submit that claims 22-39 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing, favorable consideration and passage to issue of the present application is respectfully requested. If any points remain at issue that may best be resolved through a personal or telephonic interview, the examiner is respectfully requested to contact the undersigned at the telephone number listed below.


Dated: February 28, 2006

Respectfully submitted,
RONALD W. FRASER, ET. AL

GENERAL MOTORS CORPORATION
General Motors Legal Staff
Mail Code 482-C23-B21
300 Renaissance Center
P.O. Box 300
Detroit, MI 58265-3000
Phone: (313) 665-4714

Anthony Luke Simon
Registration No. 34,434
Attorney for Applicant

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



Frank C. Nicholas
Registration No. 33,983
Attorney for Applicant